

Attorney Docket No. 52719.00009
(formerly 19608-000230US)

REMARKS

Claims 1 - 6, 11 - 15, 20 - 24, 29 - 33 and 38 - 42 were pending in the instant application when last examined. Claims 1 - 6, 11 - 15, 20 - 24, 30 - 33, 38, 41 and 42 were rejected. Claims 29, 39 and 40 were objected to. Claims 29, 39 and 40 are being amended herein to express these claims in independent format in order to place them in a condition for allowance. Claims 2 - 6, 11, 21 - 22, 24, 31 - 33 and 41 - 42 are amended to make each claim depend from one of claims 29, 39 and 40. Claims 1, 12 - 15, 20, 30 and 38 are cancelled without prejudice. New claims 43 - 55 are added. No new matter is being added and claims 2 - 6, 11, 21 - 22, 24, 29, 31 - 33 and 39 - 55 are pending in the instant application. Reconsideration and allowance are respectfully requested.

TELEPHONE MESSAGE FROM THE EXAMINER

The Applicant thanks the Examiner for the telephone message of on or about February 18, 2004, responsive to Applicant's telephone inquiry regarding the status of a decision on Applicant's Amendment After Final, filed February 10, 2004. In that message, the Examiner indicated that she did not have access to the patent application file for this case and was therefore unable to provide a decision regarding Applicant's Amendment After Final. Accordingly, Applicant submits this RCE and Response in order to provide the Examiner with time to locate the patent application file. Applicant respectfully requests that the Examiner provide him with a decision regarding the Amendment After Final and this RCE and Response.

Objections to claims 4 and 14

In item 4 on page two of the office action, Examiner indicated that objections to claims 4 and 14 have been overcome by Applicant's amendments to these claims and that the objections are hereby withdrawn.

Provisional rejection for nonstatutory double patenting

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In items 2 – 6, beginning on page 2 of the office action, the Examiner maintained the rejection of the claims under the judicially created (nonstatutory) doctrine of double patenting.

In item 2 on page two of the office action, the Examiner states that Applicant's terminal disclaimer filed June 12, 2003 was entered this paper number 9. The Examiner states that "the nonstatutory double patenting rejection still stands because though a terminal disclaimer was filed and the claims were amended and some claims were canceled, the claims in the co-pending applications 09/483,182 and 09/483,385 are not distinctly different enough to have the nonstatutory double patenting rejection withdrawn. It is suggested applicant either amend claims in the co-pending applications 09/483,182 and 09/483,385 to more clearly distinguish the novel features of each of the co-pending applications or incorporate some of the apparatus claims from the co-pending '182 application and some of the method claims from the co-pending '385 application into the apparatus claims of [this] 09/483,386 application."

Applicant respectfully disagrees and submits that it is irrelevant whether "the claims in the co-pending applications 09/483,182 and 09/483,385 are not distinctly different enough to have the nonstatutory double patenting rejection withdrawn." The issue is instead whether the judicially created doctrine of double patenting has been satisfied in order to "prevent the unjustified or improper time-wise extension of the 'right to exclude' granted by a patent and to prevent possible harassment by multiple assignees." (MPEP §804 ¶8.33) Applicant submits that it has.

As quoted by the Examiner in item 4 on page 3 of the Office Action, "a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection, based on a nonstatutory double patenting ground provided that the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b)." (MPEP §804 ¶8.33) (Emphasis added). Applicant's previously filed terminal disclaimer (accompanying Applicant's response filed June 12, 2003) to overcome the double patenting rejection indicates that the three patent applications, 09/483,386, 09/483,385 and 09/483,182 are commonly owned eliminating any possibility of "possible harassment by multiple assignees". Further because these applications were filed on the same day, there is no possibility of an unjustified or improper time wise extension of the "right to exclude" granted to a patentee. Applicant includes a copy of that Terminal Disclaimer affixed to this Response as an Appendix.

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Applicant therefore respectfully submits that the double patenting rejection is improper for at least the foregoing reason.

In item 6 on page 3 of the office action, the Examiner argues that "the subject matter claimed in the instant application is fully disclosed in the referenced copending application 09/483,385 and copending application 091483,182 and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: creating a multi dimensional report from information in a database, receiving a definition of a customer profile, receiving from a user input indicating a report configuration selection, creating a first dimension table, and creating a fact table. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804."

Applicant respectfully disagrees and submits that if the ruling in Schneller is irrelevant to the present situation. The Schneller Court's ruling that two inventions otherwise nonobvious in view of one another could be subject to double patenting **REQUIRES** that granting of a patent to a second invention enable extension of the patent right to the first. "The only rationale for supporting a double patenting rejection is "*to prevent unjustified timewise extension of the right to exclude* granted by a patent no matter how the extension is brought about." (MPEP §804, citing 397 F.2d at 354-55, 158 USPQ at 214-15). Schneller is limited to the case where an inventor originally filed a patent application that disclosed ABCXY and claimed ABCX and then, many years later, sought more claims directed to other combinations of features ABCY and ABCXY. (MPEP §804, citing 397 F.2d at 355 -56, 158 USPQ at 216).

In the present situation, by contrast, no extension of the right to exclude is possible, since Applicant previously filed a terminal disclaimer (accompanying Applicant's response filed June 12, 2003) to disclaim the terminal part of the statutory term of any patent granted on the applications, 09/483,386, 09/483,385 and 09/483,182, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 and 173 for each one of the three patent applications and because all three of the patent applications were filed on the same day.

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Applicant therefore respectfully submits that the double patenting rejection is improper for at least the foregoing reason.

The double patenting rejection based upon Schneller is likewise improper for the further reason that the procedure outlined by the MPEP 804 regarding the making of such a rejection appears not to have been complied with:

Nonstatutory double patenting rejections based on Schneller will be rare. The Technology Center (TC) Director must approve any nonstatutory double patenting rejections based on Schneller. If an examiner determines that a double patenting rejection based on Schneller is appropriate in his or her application, the examiner should first consult with his or her supervisory patent examiner (SPE). If the SPE agrees with the examiner then approval of the TC Director must be obtained before such a nonstatutory double patenting rejection can be made. (MPEP §804) (emphasis in the original).

Applicant therefore respectfully submits that the double patenting rejection is improper for at least the foregoing reason.

Applicant has amended claims in this application, the co-pending '182 application and some of the method claims from the co-pending '385 application to render the rejection moot.

Applicant therefore respectfully submits that the double patenting rejection is improper for at least the foregoing reason.

Because Applicant has previously filed a terminal disclaimer, which is appropriate under 37 CFR 1.130(b) and because the facts of this case do not merit a double patenting rejection, the rejection is improper and it should be withdrawn.

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Rejections under 35 U.S.C. § 103(a) over
Various combinations of Morgan, Brandt and Weissman

In items 7 - 16, on pages 4 through 16 of the Office Action, the Examiner rejected claims 1 - 6, 11 - 15, 20 - 24, 30 - 33, 38, 41 and 42 under 35 U.S.C. § 103 as being unpatentable over combinations of U.S. Patent No. 5,799,286 to Morgan et al. ("Morgan"), a U.S. Patent No. 6,377,983 to Brandt ("Brandt") and a U.S. Patent No. 6, 212, 524 to Weissman et al ("Weissman").

Applicants disagree with the Examiner and might otherwise traverse such rejection. The rejection is, however, rendered moot by the cancellation herein of the claims.

Allowable Subject Matter

In item 17, on pages 16 - 17 of the Office Action, the Examiner indicated that claims 29, 39 and 40 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. On page 16 of the Office Action, the Examiner states that, "Applicant's claim 29 claiming the virtual data model comprises a reverse star schema, claim 39 claiming generating a data warehouse populated with the information from the source database according to a reverse star schema meta-model, claim 39 claiming the meta-model is a reverse star schema, was not disclosed or suggested by the prior art of record." Accordingly, applicant has amended claims 29, 39 and 40 to recite each of the limitations of the independent claims from which they depend in order to place these claims in condition for allowance. Applicant also has amended dependent claims 2 - 6, 21 - 22, 24, 41 - 42 and independent claim 11 to make each of these claims depend from one of claims 29, 39 and 40. Applicant has added new claim 43 which recites a method comprising elements of claim 29, new claim 48 which recites a method comprising elements of claim 39 and new claim 54 which recites a method comprising elements of claim 40. New dependent claims 44 - 47 recite elements of dependent claims 21 - 25. New dependent claims 49 - 53 recite elements of dependent claims 2 - 6. No new matter is being added. The claims are now in condition for allowance.

FROM : Durdik

PHONE NO. : 6504933045

Mar. 09 2004 08:23AM P21

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For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Respectfully submitted,

By 
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Dated: March 9, 2004

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450

on March 9, 2004 by 